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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,606

09/27/2004

Henrik Hansson

HW-7319

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26294

7590

04/07/2008

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EXAMINER

SHAFFER, RICHARD R

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

04/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/509,606	<b>Applicant(s)</b> HANSSON, HENRIK	
	<b>Examiner</b> Richard Shaffer	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-14 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-14 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The amendment to claim 6 filed on December 3<sup>rd</sup>, 2007 is acknowledged and accepted by the examiner. The previous 35 U.S.C. 112, second paragraph rejection is hereby withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-9, 12-14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Griggs (US Patent 4,530,355).

Griggs discloses a device (**Figures 1-20**) comprising:

**[First Interpretation]** an inner member (**20**); an outer member (**30**) manually holdable to prevent rotation by a laterally directed handle (**37**); an extraction handle (**50/58**); the extraction handle is rotatable relative to the inner and outer members; the inner member (**20**) having non-circular rotary preventing members (**23**); the outer member (**30**) also having non-circular rotary preventing members (**34/35**) that cooperate with the inner member rotary preventing members (**23**) from allowing the inner member to rotate relative to the outer member; the rotary prevention members for both are provided in a rear end portion; at least one part (**70 or 80 or 90**) limit backwards movement; **90** has outer threads to engaged inner threads of the inner member (**20**);

**[Second Interpretation]** same as First Interpretation except that the direction towards handle 58 is not backwards, but forward. Thus inner threads of inner member (20) are on a "front end portion" with a conically tapering (25, **Figure 1** as well as additional structure to the right) inlet inwards toward the hole.

In regards to applicant's recitation of intended use, as long as the prior art structure is capable of the recited use, it reads on the claimed invention. In regards to applicant's recitation of "consists of", several additional components could be lumped together or merely not included to meet the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griggs in view of Roger (US Patent 6,592,587).

Griggs discloses all of the claimed limitations except for the inner extraction member having a rear and front portion with internal threading as well as lateral holes.

Roger teaches (**Figure 3b; Column 1 Line 14 through Column 2, Line 34**) the use of a front/leading portion having a threaded connection with a guidewire/K-wire in order to position a screw at a correct angle as well as to avoid pushing away a second bone piece in which one desires a first bone piece to be fixed. It would have been obvious to one having ordinary skill in the art at the time of invention to provide for a

distal end with an internal threading as shown in **Figure 3b** of Roger to the device of Griggs to ensure proper alignment of a screw as well as proper fixation of bone fragments.

It is well known to provide for a cannulation with lateral holes in order to allow for bone in-growth as well as to allow for curable substances to be ejected through to fix an implant to bone. It would have been further obvious to one having ordinary skill in the art to provide the inner member with lateral openings to allow for bone in-growth or optionally for exit ports to allow curable bone cement or bone morphogenetic protein to pass through to improve implant fixation.

### ***Response to Arguments***

Applicant's arguments filed on December 3<sup>rd</sup>, 2007 have been fully considered but they are not persuasive.

Applicant continues to contend the device of Griggs cannot perform the claimed functional limitations set forth in the claim. Again, applicant is informed that the claims merely state that the device is capable of being used for removing a pin (claim 1) and/or sleeve (claim 17). The pin and sleeve are functionally recited, there are no requirements for a pin or sleeve to be disclosed in the reference, merely that some conceptualized pin and sleeve could be acted upon as claimed by the claimed invention. Therefore, the device of Griggs would not be modified in order to meet the limitations, and is inherently capable of performing the function as disclosed.

In addition, regarding the argument that the device of Griggs does not meet the limitation, "the extraction handle (14) can cooperate with the inner extraction member

(12) in order to draw the inner extraction member (12) backwards in the direction of extraction (R) only when the inner extraction member (12) is inserted into the outer extraction member (13) so that the rotary preventing members (29, 32) cooperate with each other.” is not found persuasive. One can choose not to perform the task at any other time, except “only when” the inner and outer members are engaged. The language is not limiting the function to the inability of performing any other time. Merely that it is restricted for some reason. Therefore, choice in performing it at one time, versus another is proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Shaffer whose telephone number is (571)272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard Shaffer/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733